

## **REMARKS**

### **I. Introduction**

Claims 2 to 10, 12 to 17, 27, and 31 are currently pending in the present application. It is respectfully submitted that all of the presently pending claims are allowable, and reconsideration is respectfully requested.

As an initial matter, Applicants once again respectfully request acknowledgment of the claim for foreign priority and an acknowledgment that the certified copy of the priority application was received in the parent application, i.e., U.S. Patent Application Serial No. 09/971,504.

### **II. Rejection of Claims 2 to 10, 12 to 17, 27 and 31 Under 35 U.S.C. § 112, 1<sup>ST</sup> ¶**

Claims 2 to 10, 12 to 17, 27 and 31 were rejected under 35 U.S.C. § 112, first paragraph as allegedly failing to comply with the enablement requirement. Applicants respectfully submit that claims 2 to 10, 12 to 17, 27 and 31 fully comply with the enablement requirement of 35 U.S.C. § 112 for at least the following reasons.

The Final Office Action alleges that the maximum roughness, average pore diameter, and average grain size of score marks on the brake surface would depend on the type of brake and its condition of use and, therefore, that it would require undue experimentation to determine what the average grain size of the claimed protective substance is supposed to be.

Applicants respectfully submit that one skilled in the art would not have to unduly experiment to determine the maximum roughness, average pore diameter, and average grain size of score marks on the surface of brake disks and brake drums, including those used in cars, trucks, and heavy machinery.

Further, Applicants respectfully submit that one skilled in the art would further understand that the maximum roughness, average pore diameter, and average grain size of score marks on the surface of brake disks and brake drums are consistent and/or are known throughout the life of the brake. Therefore, the average grain size of the score marks on the brake surface would not depend on the condition of brake use, i.e., whether it is new or used, etc.

Therefore, for the foregoing reasons, withdrawal of this rejection is respectfully requested.

**III. Rejection of Claims 2 to 10, 12 to 17, 27 and 31 Under 35 U.S.C. § 112, 2<sup>nd</sup> ¶**

Claims 2 to 10, 12 to 17, 27 and 31 were rejected under 35 U.S.C. § 112, second paragraph as allegedly indefinite. Applicants respectfully submit that claims 2 to 10, 12 to 17, 27 and 31 fully comply with the definiteness requirement of 35 U.S.C. § 112 for at least the following reasons.

The Final Office Action alleges that it is not clear the type of brake encompassed by the claims and, therefore, that it is unclear what is encompassed by the phrase "substantially equal to at least one of a maximum roughness, an average pore diameter and an average size of score marks." The definiteness requirement of 35 U.S.C. § 112, second paragraph is satisfied if the claims set out and circumscribe a particular subject matter with a reasonable degree of clarity and particularity. M.P.E.P. § 2173.02. According to M.P.E.P. § 2173.02, the Examiner's focus during examination of claims for compliance with the requirement for definiteness of 35 U.S.C. § 112, second paragraph is whether the claim meets the threshold requirements of clarity and precision, not whether more suitable language or modes of expression are available. There is absolutely nothing unclear about the phrase "substantially equal to at least one of a maximum roughness, an average pore diameter and an average size of score marks."

That the Final Office Action refers to the rejection raised under 35 U.S.C. § 112, first paragraph makes even more readily clear that the present rejection is based on an apparent misapprehension of the definiteness requirement under 35 U.S.C. § 112, second paragraph.

The Final Office Action's reference to Ex parte Slob, 157 USPQ 172 is entirely misplaced. In this regard, it is noted that the presently claimed lacquer is not characterized simply by properties because one skilled in the art would have an understanding as to the composition of the claimed protective brake lacquer which, therefore, need not be specifically recited in the claims.

Therefore, withdrawal of this rejection is respectfully requested.

**IV. Rejection of Claim 2 to 4, 10, 12 to 14, 17, 27, and 31 Under 35 U.S.C. § 102(b)**

Claims 2 to 4, 10, 12 to 14, 17, 27, and 31 were rejected under 35 U.S.C. § 102(b) as anticipated by German Published Patent Application No.

43 14 432 ("DE '432"). Applicants respectfully submit that the present claims are patentable over DE '432 for at least the following reasons.

DE '432 purportedly relates to a corrosion protection agent for organically bonded friction linings. Nowhere does DE '432 disclose, or even suggest, a protective substance having an average grain size that is substantially equal to at least one of a maximum roughness and an average size of score marks of a braking surface of at least one of a brake disk and a brake drum, as required by claim 10, a protective substance having an average grain size substantially equal to at least one of a maximum roughness, an average pore diameter and an average size of score marks of the braking surface of the at least one of the brake disk and the brake drum, as required by claim 17, and a protective substance configured to fill one of a pore and a score of average size on the braking surface of the at least one of the brake disk and the brake drum upon abrading the corrosion protective coating composition by a brake lining during braking, as required by claim 31. DE '432 merely discloses the use of an inorganic zinc compound and does not disclose that the grain size of the inorganic zinc compound is substantially equal to at least one of a maximum roughness, an average pore diameter, and/or an average size of score marks of a braking surface of a brake disk or brake drum to which it may be applied. The abstract of DE '432 is absolutely silent with respect to the grain size of the inorganic zinc compound.

The Final Office Action seems to consider it to be Applicants' burden to establish that DE '432 does not disclose the grain size recited in claims 10, 17, and 31. Applicants respectfully disagree. In order to establish a prima facie case of anticipation, the Examiner must provide a reference that discloses a protective substance within the recited size range. Providing a reference that discloses an inorganic zinc compound without any information as to the grain size of the inorganic compound does not meet the Examiner's burden. Further, the silence of DE '432 regarding the grain size of the inorganic zinc compound is not properly interpreted as disclosing every possible grain size. Indeed, the reading of DE '432 as disclosing every possible grain size yields impossible combinations of grain size and coating thickness, for example, combinations in which the layer thickness is smaller than the grain size.

Nor does the Final Office Action provide any support for its position that the grain size disclosed by DE '432 is inherently one that is substantially equal to at

least one of a maximum roughness, average pore diameter, and an average size of score marks other than the fact that the compositions are used for the same purpose. It is inappropriate to assume that just because both compositions are used to coat brakes that they necessarily have the same grain size. Therefore, it is respectfully submitted that DE '432 does not anticipate claims 10, 17, and 31.

As for claims 2 to 4, and 27, which ultimately depend from claim 10 and therefore include all of the features of claim 10, and claims 12 to 14, which depend from claim 17 and therefore include all of the features of claim 17, Applicants submit that these claims are patentable over DE '432 for at least the same reasons provided above.

In view of all of the foregoing, withdrawal of this rejection is respectfully requested.

**V. Rejection of Claim 2 to 7, 12 to 17, 27, and 31 Under 35 U.S.C. § 102(b)**

Claims 2 to 7, 12 to 17, 27, and 31 were rejected under 35 U.S.C. § 102(b) as anticipated by European Patent No. 0 976 795 ("EP '795"). Applicants respectfully submit that the present claims are patentable over EP '795 for at least the following reasons.

EP '795 purportedly relates to an antifriction coating for metals and a process for its manufacture. Applicants respectfully submit that EP '795 does not disclose, or even suggest, a protective substance having an average grain size that is substantially equal to at least one of a maximum roughness and an average size of score marks of a braking surface of at least one of a brake disk and a brake drum, as required by claim 10, a protective substance having an average grain size substantially equal to at least one of a maximum roughness, an average pore diameter and an average size of score marks of the braking surface of the at least one of the brake disk and the brake drum, as required by claim 17, and a protective substance configured to fill one of a pore and a score of average size on the braking surface of the at least one of the brake disk and the brake drum upon abrading the corrosion protective coating composition by a brake lining during braking, as required by claim 31. EP '795 does not disclose exactly what is claimed and does not enable one skilled in the art to make or use the subject matter as claimed herein.

The Final Office Action does not provide any support for its position that the grain size disclosed by EP '795 is inherently one that is substantially equal to 1390521

at least one of a maximum roughness, average pore diameter, and an average size of score marks other than the fact that the compositions are both used to coat brakes. Applicants respectfully submit that it is inappropriate to assume that just because both coatings are used to coat brakes that they necessarily have the same grain size.

As for claims 2 to 7, and 27, which ultimately depend from claim 10 and therefore include all of the features of claim 10, and claims 12 to 17, which depend from claim 17 and therefore include all of the features of claim 17, Applicants submit that these claims are patentable over EP '795 for at least the same reasons provided above.

In view of all of the foregoing, withdrawal of this rejection is respectfully requested.

#### VI. Conclusion

Applicants respectfully submit that all of the pending claims of the present application are in condition for allowance. Prompt reconsideration and allowance of the present application are therefore earnestly solicited.

Respectfully submitted,

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By: /Clifford A. Ulrich/  
Clifford A. Ulrich  
Reg. No. 42,194

KENYON & KENYON LLP  
One Broadway  
New York, New York 10004  
(212) 425-7200  
**CUSTOMER NO. 26646**